

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| In re United States Patent Application of: |) | Docket No.: | 4230-101 |
| Applicants: SHIMURA, Tokihiro, et al. |) | Conf. No.: | 6700 |
| Application No.: 10/690,073 |) | Art Unit: | 1755 |
| Date Filed: October 21, 2003 |) | Examiner: | MARCHESCHI, Michael A. |
| Title: ABRASIVE, AND ABRASIVE MANUFACTURING METHOD AND DEVICE |) | Customer No.: | 23448 |

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JAN 11 2006****FACSIMILE TRANSMISSION CERTIFICATE****ATTN: Examiner Michael A. Marcheschi****Fax No. (571) 273-8300**

I hereby certify that this document is being filed in the United States Patent and Trademark Office, via facsimile transmission Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on **January 11, 2006**, to United States Patent and Trademark Office facsimile transmission number (571) 273-8300.

38
Number of Pages (including cover)

Kate Turner
Kate Turner

January 11, 2006

Date

**RESUBMISSION OF RESPONSE TO OCTOBER 3, 2005 OFFICE ACTION AND
REQUEST FOR 1-MONTH EXTENSION OF TIME IN U.S. PATENT APPLICATION
NO. 10/690,073**

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

Enclosed and resubmitted herewith is a copy of the "Response to October 3, 2005 Office Action and Request for 1-Month Extension of Time in U.S. Patent Application No. 10/690,073," as fax-filed in the USPTO on January 11, 2006 by transmission to USPTO Central Facsimile number (571) 273-8300.

4230-101

Although the Response was indicated by the Transmission Report generated by the undersigned attorney's fax machine as having been fully transmitted (see copy of Transmission Report enclosed herewith), 2 Auto-Replies confirming such filing were sent by the PTO to the undersigned attorney (see Auto-Replies attached hereto). Note that the first Auto-Reply reports successful receipt of 15 pages of the document, and the second Auto-Reply reports successful receipt of 20 pages of the document, for a total of 35 pages.

The Response is therefore being resubmitted herewith, to secure an single Auto-Reply communication from the USPTO confirming such filing, and to ensure that the document is received by the USPTO in its entirety and without duplication.

To prevent duplicate charge of the 1-month extension fee, the Credit Card Form authorizing payment in the total amount of \$120.00, transmitted as page 34 with the originally filed response, will not be resubmitted.

Respectfully submitted,



Steven J. Hultquist
Reg. No. 28,021
Attorney for Applicants

INTELLECTUAL PROPERTY/
TECHNOLOGY LAW
Phone: (919) 419-9350
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Attorney File No.: 4230-101

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| IN THE UNITED STATES PATENT AND TRADEMARK OFFICE | | | | | | | |
| In re United States Patent Application of: | | | | Docket No.: | | 4230-101 | |
| Applicant: SHIMURA, Toshihiro, et al. | | | | Examiner: | | MARCHESCHI, Michael A. | |
| Application No.: 10/690,073 | | | | Group Art Unit: | | 1755 | |
| Date Filed: October 31, 2005 | | | | Confirmation No.: | | 6780 | |
| Title: ABRASIVE AND ABRASIVE MANUFACTURING METHOD | | | | Customer No.: | | 23448 | |
| FACSIMILE TRANSMISSION CERTIFICATE | | | | | | | |
| ATTN: Examiner Michael A. MARCHESCHI | | | | | | | |
| Facsimile No.: (571) 273-8300 | | | | | | | |
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| Steven J. Hudgins | | | | | | | |
| January 11, 2006 | | | | | | | |
| Date | | | | | | | |
| RESPONSE TO OCTOBER 3, 2005 OFFICE ACTION AND REQUEST FOR 1-MONTH EXTENSION OF TIME UNDER 35 USC 1.136(a) IN U. S. PATENT APPLICATION NO. 10/690,073 | | | | | | | |
| Mail Stop AF Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450 | | | | | | | |
| Sir: | | | | | | | |
| This responds to the October 3, 2005 final Office Action in the above-referenced patent application. | | | | | | | |
| PAGE 3/24 * RCVD AT 10/12/2005 10:42:01 AM Eastern Standard Time * SVR:USPTO-EFXXF-6/33 * DNIS:2738300 * CSID:9194199354 * DURATION (mm-ss):15:09 | | | | | | | |

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This rejection is meritless for multiple reasons. First, it is improper for the Patent Office to limit all claims to specific examples provided in a specification. *In re Andersen*, 176 USPQ 331, 333 (CCPA 1973). Second, and more importantly, this reading of claim 11 ignores a commonsense reading of claim 10, on which claim 11 depends. Specifically, claim 11 states that "the substance comprises a material selected from the group consisting of stearic acid and anhydrous silica," while claim 10 requires that the "substance ... is attached to a part or the entire surface of the inorganic metal powder." In this respect, the claim only requires that the substance be in any form attachable to the powder. For example, the substance could be in the form of a film or a coating, or any other suitable form.

Since the examiner prints to no limiting language in the specification indicating that "the substance" of claim 11 cannot be a non-powder, any illustrative examples should be treated as non-limiting of the physical form of the substance within the plain meaning of claim 11.

As before, Applicants hereby incorporate by reference the preceding discussions of the two-part test of *In re Fisher* (166 USPQ at 23-24) and apply them to claim 11. There is no doubt that, with the benefit of the present patent disclosure, one of ordinary skill in the art could: (1) attach anhydrous silica to a part of or the entire surface of the inorganic metal powder in any form or using any method known in the art; and (2) predict the performance of such other embodiments applying known scientific laws.

Based on the foregoing, the examiner has not advanced acceptable reasoning inconsistent with enablement sufficient to establish a *prima facie* case of a lack of enablement required to support the present rejection under 35 USC § 112. Therefore, withdrawal of the rejection under 35 USC § 112 is respectfully requested.

e) "Pressurized" limitation

Claims 24 and 25 require ejection of a "pressurized fluid" into molten metal that is ejected from a nozzle, with the fluid functioning to solidify the molten metal into the form of a powder. In the October 2, 2005 Office Action, the examiner rejected claims 23 and 24 under 35 USC 112, first paragraph, for utilizing the term "pressurized." The examiner conceded that "the specification states that pressure can be used" but indicated that such disclosure "is limited to high pressure" and indicated that as now claimed the term "pressurized" means the use of any pressure (i.e., low

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Page 1/20 * RCVD AT 1/11/2006 11:03:03 AM [Eastern Standard Time] * SVR:USPTO-EFAX-6/33 * DNIS:2738300 * CSID:9194199354 * DURATION (mm-ss):15-26

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| In re United States Patent Application of: | Docket No.: | 4230-101 |
| Applicant: SHIMURA, Tokihiko, et al. | Examiners: | MARCHESCHI, Michael A. |
| Application No.: 10/690,073 | Group Art Unit: | 1755 |
| Date Filed: October 21, 2003 | Confirmation No. | 6700 |
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Steven J. Huhguts
January 11, 2006
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RESPONSE TO OCTOBER 3, 2005 OFFICE ACTION AND REQUEST FOR 1-MONTH EXTENSION OF TIME UNDER 35 USC 1.136(a) IN U. S. PATENT APPLICATION NO. 10/690,073

Mail Stop AP
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Sir:

This responds to the October 3, 2005 final Office Action in the above-referenced patent application.

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Abbreviations:

HS: Host send
HR: Host receive
WS: Waiting send

PL: Polled local
PR: Polled remote
MS: Mailbox save

MP: Mailbox print
CP: Completed
FA: Fail

TU: Terminated by user
TS: Terminated by system
RP: Report
G3: Group 3
EC: Error Correct

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| In re United States Patent Application of: |) | Docket No.: | 4230-101 |
| Applicant: |) | Examiner: | MARCHESCHI, |
| Application No.: |) | Group Art Unit: | 1755 |
| Date Filed: |) | Confirmation No. | 6700 |
| Title: |) | Customer No. | |
| ABRASIVE, AND |) | | |
| ABRASIVE |) | | |
| MANUFACTURING |) | | |
| METHOD |) | | |

23448

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NO. 10/690,073**

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This responds to the October 3, 2005 final Office Action in the above-referenced patent application.

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The currently-pending claims are provided in **Section I (Statement of the Claims)** hereof.

Remarks relating to the substance of the October 3, 2005 Office Action are set out in **Section II (Remarks)** hereof.